

REMARKS

Claims 1-27 were examined in the non-final office action dated 09/27/2007 ("Outstanding Office Action"). Applicants note with appreciation that claims 26 and 27 were indicated to contain allowable subject matter.

5 Claims 1-2, 7-9, 14-15, and 20-21 were rejected under 35 U.S.C. 102(e) as being anticipated by US Published Application Number 2002/0023152 naming as inventor Oguchi (hereafter Oguchi). Claims 3-4, 10-11, 16-17, and 22-23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Oguchi in view of US Patent Number 6,496,439 issued to McClure. Claims 5-6, 12-13, 18-19, and 24-25 were rejected under 35 U.S.C. 103(a) as being
10 unpatentable over Oguchi in view of US Patent Number 6,888,837 issued to Cunningham *et al.*

Without acquiescing to any of the Examiner's assertions, Applicants swear behind Oguchi and respectfully request the Examiner to remove Oguchi as a prior art reference.

In particular, Applicants swear behind Oguchi as provided under 37 CFR § 1.131
15 entitled "Affidavit or Declaration of prior invention" by submitting a declaration (hereafter "declaration") according to the procedure further outlined in 37 CFR § 131(b) and MPEP § 715. As noted there, one of the ways to swear behind requires a showing:
 (A) Conception of the invention prior to the effective date of the reference; and
 (B) Coupled with due diligence from prior to the reference date to the filing date
20 of the application (constructive reduction to practice).

The effective date of the Oguchi reference is **April 03 2001, the filing date accorded by the US patent office**. It is noted that the foreign application priority date of Apr 4 2000 is **not** the effective date of the reference. See, for example, "MPEP § 2136.03 (I): Critical Reference Date - Foreign Priority Date" which states as follows:

25 *Reference's Foreign Priority Date Under 35 U.S.C. 119(a)-(d) and (f) Cannot Be Used as the 35 U.S.C. 102(e) Reference Date*
35 U.S.C. 102(e) is explicitly limited to certain references "filed in the United States before the invention thereof by the applicant" (emphasis added). ***Foreign applications' filing dates***

that are claimed (via 35 U.S.C. 119(a) - (d), (f) or 365(a)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may not be used as 35 U.S.C. 102(e) dates for prior art purposes. This includes international filing dates claimed as foreign priority dates under 35 U.S.C. 365(a). Therefore, the foreign priority date of the reference under 35 U.S.C. 119(a)-(d) (f), and 365(a) cannot be used to antedate the application filing date. In contrast, applicant may be able to overcome the 35 U.S.C. 102(e) rejection by proving he or she is entitled to his or her own 35 U.S.C. 119 priority date which is earlier than the reference's U.S. filing date. In re Hilmer, 359 F.2d 859, 149 USPQ 480 (CCPA 1966) (Hilmer I) (Applicant filed an application with a right of priority to a German application. The examiner rejected the claims over a U.S. patent to Habicht based on its Swiss priority date. The U.S. filing date of Habicht was later than the application's German priority date. **The court held that the reference's Swiss priority date could not be relied on in a 35 U.S.C. 102(e) rejection.** Because the U.S. filing date of Habicht was later than the earliest effective filing date (German priority date) of the application, the rejection was reversed.). See MPEP § 201.15 for information on procedures to be followed in considering applicant's right of priority. (**Emphasis Added**)

In the amendment paper filed on February 14 2006, Applicants had established a conception date of prior to February 20 2001 and diligence from that date to the filing date (July 24 2001) of the subject/present application. In the Office Action Dated 06/07/2006, the Examiner agreed that the submitted evidence is persuasive to establish the same.

At least for such a reason, Oguchi is not effective prior art under 35 U.S.C. § 102(e). Withdrawal of the outstanding rejections and continuation of examination is respectfully requested. The Examiner is invited to telephone the undersigned representative at 707.356.4172 if it is believed that an interview might be useful for any reason.

Respectfully submitted,
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Signature

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